

**Amendment Under 37 C.F.R. § 1.116
U.S. Serial No. 09/847,443**

Attorney Docket No.: Q64369

AMENDMENTS TO THE DRAWINGS

Applicant is submitting one replacement drawing sheet including FIG 3. Applicant has corrected the reference character 30 identifying the network connecting terminal 14 and server 15. Applicant has also identified other segments of network 20 in Fig. 3.

Attachment: One Replacement Sheet

REMARKS

Claims 1-4 and 6-14 are all the claims pending in the application.

I. Formalities

Applicant thanks the Examiner for acknowledging the claim for foreign priority and for confirming receipt of the priority document.

II. Drawing

Applicant is submitting one replacement drawing sheet including FIG 3. Applicant has corrected the reference character 30 identifying the network connecting terminal 14 and server 15. Applicant has also identified other segments of network 20 in Fig. 3.

III. Claim Rejections - 35 U.S.C. § 112

1) The Examiner has rejected claims 8 and 11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner has also rejected claims 8 and 11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner contends that there are no first network and second network as claimed by the Applicant according to Fig. 3 and corresponding pages of the specification.

In the response of May 24, 2005, Applicant submitted that the specification fully supports the use of a second network, and Applicant specifically noted that at page 9, line 27 to page 10, line 2, the original specification states “the line between the user terminal 14 and the address server 15 need not to be a telephone line, nor a packet line, but may be the Internet for convenience.” The Examiner contends that Fig. 3 only relates to one telephone network. The

Examiner also contends that an interpretation of Fig 3. to include two networks is contradictory to Fig. 1 and the specification at page 8, lines 14-27. Applicant disagrees.

As the Examiner notes, Fig. 1 provides an illustration of the prior art. The description with respect to Fig. 1 is generalized and is mainly intended to provide background information for one skilled in the art with respect to understanding the present invention. The fact that the line between User 4 and carrier 5 of Fig 1 appears similar to that in Fig. 3 is not relevant since the non-limiting embodiments of the present invention are taught using Fig. 3, not Fig. 1.

In addition, in the response of May 24, Applicant incorrectly identified the line segment illustrating communications between devices rather than the line illustrating the network connection. This error has been corrected in the replacement drawing.

In describing line 30, the Specification states “the line [30] between the user terminal 14 and the address server 15 need not to be a telephone line, nor a packet line, but may be the Internet for convenience.” When taken in context with the disclosure at page 9, lines 17-26, non-limiting examples of line 30 between User Terminal 14 and Address Server 15 can be a telephone line, a packet line or the Internet. Therefore, User Terminal 14 and Address Server 15 are not limited to just communications over a telephone line, but can also communicate using the Internet. Accordingly, page 9, line 27, to page 10, line 2, of the Specification supplements, rather than contradicts, the Specification at page 8, lines 20 to 27, which provides a general overview of the main features in Fig. 3.

Since the Internet would commonly be considered a network by one skilled in the art, Applicant submits that the original specification fully supports and enables one skilled in the art to practice the invention as set forth in claims 8 and 11.

2) The Examiner has rejected claim 14 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner has also rejected claim 14 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner contends that the recitation "wherein if the inquiring of the address server about the address corresponding to the name of the computer on the terminating side returns an Internet Protocol (IP) address, then the communication with the terminating side computer is in IP mode" is not supported by the specification.

As best understood, the Examiner is contending that claim 14 is not enabled because the features recited in the claims would require two networks to function, and the written description does not support two networks because "Applicant did not establish ... the existence of [the] second network as the Internet in fig. 3." Office Action at page 5.

Applicant submits that the Specification and Fig. 3 fully establish the existence of the second network for at least the reasons given above with respect to claims 8 and 11. Accordingly, Applicant submits that the specification fully supports and enables the features recited in claim 14.

Finally, in further response to the Examiner's comments on pages 4 and 5 of the Office Action, Applicant submits that the specification sets forth that user terminals may obtain address for computers on a network by using a server and that the user terminals may then communicate with one another. After reading the specification, one skilled in the art would recognize how to set up the search functions on the server to provide the desired addresses to the user terminals, and one skilled in the art would also recognize how to set up the user terminals to obtain and use the address provided by the server to communicate with other user terminals. In addition, one

skilled in the art would also know how to set up communications between computers and/or servers on a normal telephone line, an ISDN line and the Internet.

IV. Claim Rejections - 35 USC § 102

The Examiner has rejected claims 1-5, 7-8, 11 and 14 under 35 U.S.C. § 102(e) as being anticipated by Sabatier *et al.* (US 6,754,708) ["Sabatier"]. For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites a computer communication network that comprises "a first computer identified by an address recognizable by a telephone network when the first computer connects to the telephone network; a second computer identified by an address recognizable by the telephone network when the second computer connects to the telephone network; and an address server for correlatively storing addresses, which include the addresses recognizable by the telephone network, and names corresponding to the addresses, wherein the first computer is configured to request from the address server an address by transmitting a name of the second computer, and is configured to communicate with the second computer using the address received from the address server."

The Examiner contends that

1. As per claim 1, Sabatier et al teach a computer communication network 1, comprising:
2. a first computer identified by an address recognizable by a telephone network when the first computer connects to the telephone network (computer 1 is connected to telephone network 4 with its **recognizable telephone number (N1, IP1.** see abstract);
3. a second computer identified by an address recognizable by the telephone network when the second computer connects to the telephone network (computer 1 is connected to telephone network 4 with its **recognizable telephone number (N2, IP2.** see abstract);
4. address server (server 5) for correlatively storing the **address defined in the telephone network and a name (N1, N2)**

corresponding to the address (IP1 and IP 2) [abstract ; col. 2, lines 20-35; col. 3, lines 11-32 and col. 6, lines 50-67], wherein the first computer is configured to request from the address server an address by transmitting a name of the second computer, and is configured to communicate with the second computer using the address received from the address server (abstract and col. 3, lines 11-32 and col. 6, lines 6-67).

Office Action at pages 9 and 10 (bold added for emphasis).

As best understood, the Examiner is contending that the claimed addresses recognizable in the telephone network for the first and second computers are both telephone numbers (N1, N2) and IP addresses (IP1, IP2). The Examiner also contends that the claimed names corresponding to the stored addresses are telephone numbers (N1, N2). Finally, based on the cited sections, the Examiner is contending that the claimed address received from the address server is an internet address (IP1, IP2).

Accordingly, the Examiner is contending that telephone numbers N1, N2 correspond to both the claimed addresses recognizable in the telephone network and the claimed names corresponding to the stored addresses. Applicant submits that the Examiner's use of the same prior art element (telephone numbers (N1, N2)) to contend that two different claim elements are disclosed is improper.

Therefore, Applicant submits that Sabatier does not disclose all the elements as set forth in claim 1.

In addition, Sabatier discloses that terminals 1 and 2 connect to the server 5 in order to communicate over the Internet using IP addresses (col. 3, line 50 to col. 4, line 3). The server 5 uses the telephone number N1, N2 of the terminals to associate the terminals with their respective IP addresses and stores the telephone numbers and IP addresses in directory 54 (col. 3, lines 21-26 and lines 50-64). Sabatier also discloses that terminal 1 transmits the telephone

number N2 of terminal 2 to server 5 in order to receive terminal 2's IP address (IP2) for establishing communications.

Therefore, Sabatier discloses that the addresses sent by server 5 for setting up communications with the first and second terminals are limited to IP addresses. There is no disclosure or suggestion in Sabatier that the IP addresses are recognizable by a telephone network. Accordingly, Sabatier does not disclose or suggest a server “correlatively storing addresses, which include the addresses recognizable by the telephone network ... [which are then] received from the address server [by the first computer to establish communications with the second computer]” as set forth in claim 1. (emphasis added).

Because claims 2-4, 7 and 14 depend on claim 1, Applicant submits that these claims are patentable at least by virtue of their dependency.

Claim 8 recites a method of communications on a computer network that comprises “communicating with the server from the first computer to initially determine the address of the at least one second computer by communicating on the second network; and connecting to the at least one second computer on the first network using the address of the at least one second computer provided by the server, wherein the first network is a telephone network.” The Examiner still contends that the claimed communication between the first computer and server and the claimed communication between the first computer and the second computer are disclosed.

Because the Examiner has not substantively rebutted Applicant's argument filed in the response of May 24, Applicant incorporates the arguments in their entirety.

Applicant further emphasizes that Sabatier discloses that terminals 1 and 2 first communicate over a telephone network 4 to request communications over Internet 3 (col. 3, lines 50-52). Then, the terminals connect to a server 5 to transmit IP addresses, which then permits the terminals to communicate over the Internet 3 (col. 3, line 50 to col. 4, line 3). Accordingly, Sabatier discloses the opposite of the features as set forth in claim 8.

Sabatier does not disclose or suggest that a terminal initially connect to a server on a second network (i.e., the Internet in Sabatier) to receive the address of another terminal in order to communicate over a telephone network. In fact, this feature is not needed since the terminals in Sabatier already know the telephone number of the other before any communication takes place. Accordingly, Sabatier does not disclose or suggest at least the claimed communication between the first computer and the server.

Because independent claim 11 recites features similar to those given above with respect to claim 8, Applicant submits that claim 11 is patentable for at least reasons similar to those given above with respect to claim 8.

V. Claim Rejections - 35 USC § 103

The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Sabatier in view of Szutu (US Pub. 2001/0047395) [“Szutu”]. For at least the following reasons, Applicant traverses the rejection.

Because the Examiner has not substantively rebutted Applicant’s argument filed in the response of May 24, Applicant incorporates the arguments in their entirety.

In addition, because Szutu does not cure the deficient teachings of Sabatier with respect to claim 1, Applicant submits that claims 6 is patentable at least by virtue of its dependency.

The Examiner has rejected claims 9, 10, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Sabatier in view of Yablon (US 5,764,731) ["Yablon"]. For at least the following reasons, Applicant traverses the rejection.

Because the Examiner has not substantively rebutted Applicant's argument filed in the response of May 24, Applicant incorporates the arguments in their entirety.

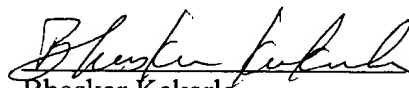
In addition, because Yablon does not cure the deficient teachings of Sabatier with respect to claims 8 and 11, Applicant submits that claims 9, 10, 12 and 13 are patentable at least by virtue of their respective dependencies.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Bhaskar Kakarla
Registration No. 54,627

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: November 23, 2005